

REMARKS

This responds to the Final Office Action dated August 7, 2008.

Claims 25 and 42 are amended, no claim is canceled, no new claim is added; as a result, claims 25-31 and 42 are now pending in this application.

§112 Rejection of the Claims

Claims 25-31 and 42 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 25 has been amended to provide the Examiner clarification as to the limitations referred to by the Examiner in the Office Action. More specifically, the amendments to claim 25 positively indicate the two techniques used to locate the first advertisement, as follows:

*"wherein the first advertisement is located based on one of
a dedicated broadcast frequency from a transmission center and
scanning a set of broadcast frequencies from the transmission center."*

Applicants submit that the 112 rejection has been overcome.

§103 Rejection of the Claims

Claims 25-31 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller (U.S. Patent No. 7,266,832) in view of Lazaridis (U.S. Patent No. 7,076,244).

Amended claim 15 recites:

*"compiling consumer profile information;
determining whether a first advertisement matches the consumer profile information,
wherein the first advertisement is located based on one of a dedicated broadcast frequency from
a transmission center and scanning a set of broadcast frequencies from the transmission center;
in the event that the first advertisement matches the consumer profile information,
recording the first advertisement; and
in the event that the first advertisement does not match the consumer profile information,
ignoring the first advertisement."*

(Emphasis added.)

On page 4 of the Office Action, the Examiner admitted that Miller does not disclose determining whether the first advertisement is broadcast by a transmission center on a dedicated frequency or scanning a set of broadcast frequencies to locate the first advertisement. The Examiner then stated that Lazaridis (Figure 7, step 308 and col. 13, lines 34-35) discloses locating an appropriate ad targeted to a user by scanning many broadcast channels.

On page 5 of the Office Action, the Examiner alleged that "(I)t would have been obvious to one skill in the art at the time the invention was made to add that teaching of Lazaridis to Miller to allow locating an appropriate targeted ad when it is not known where the ad is located."

The Examiner further concluded that "(I)t would also have been obvious to one skilled in the art that in the alternative, if a dedicated channel is known to provide such targeted ad, to turn a receiver to that channel, since that would have been a more efficient method to locate the ad."

The Examiner then attempted to justify the above conclusion by alleging that "(I)n other words...if an ad is to be located on a dedicated channel, such knowledge derived from e.g. some source independent of scanning done in Lazaridis or even, e.g. after scanning a few channels as done in Lazaridis it would have been obvious to a PHOSITA to either not start the scanning or stop the scanning as appropriate because doing otherwise would have been inefficient or wasting resources." Applicant believes that the Examiner meant to refer to one skilled in the art by the word PHOSITA.

From the Examiner's allegation indicated above, it is clear that the Examiner admitted that neither Miller nor Lazaridis disclose a dedicated channel and locating an ad in the dedicated channel.

Applicant submits that the Office Action did not make out a *prima facie* case of obviousness because the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Applicant submits that, at least for the above reason, claim 25 is patentable over Miller and Lazaridis, individually or in combinations. The 103 rejection has been overcome. At least for the same reason, claim 42 is also patentable.

Since claim 26-31 depend from claim 25 and since claim 25 is patentable, Applicant submits that claims 26-31 are also patentable.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4059 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7 day of August, 2008.

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